REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed December 30, 2005. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

Claims 1-25 have been provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of co-pending application Serial No. 10/027,066 and that of claims 1-25 of co-pending application Serial No. 10/028,256. Though this is a provisional rejection and not ripe for response by Applicants, this ground of rejection is respectfully traversed as being admittedly inappropriate. At page 11, paragraph 9, of the pending official action, the Examiner explicitly admits that the claimed subject matter is different, thus specifically precluding a finding of statutory double patenting.

The Examiner has rejected claims 1-11, 16-21, and 23-25 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2003/0041053 A1, issued in the name of Roth (hereinafter referred to as "Roth"). This ground of rejection is respectfully traversed as to amended claims 1-11, 16-21, and 23-25 for the reasons provided below.

The standard for the finding of anticipation during the examination process may be found in MPEP 2131, which states in part:

> TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM
>
> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "**The identical invention must be shown in as complete detail as is contained in the ... claim.**" *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection of amended claims 1-25 as anticipated by Chau is respectfully traversed because "each and every element as set forth in the claim[s] is" **not** "found, either expressly or inherently described" in Chau and to the extent found in Chau, "**the identical invention**" is not "**shown in as complete detail as is contained in the .....claim**"..

In accordance with a major aspect of Applicants' invention, a user terminal generates a service request in a first format which is transferred via a publically accessible digital data communication network to a legacy data base management system which must convert the service request into a different format to permit the service request to be honored through the execution of an ordered sequence of command language script. In each claim, the user terminal embeds a direct call to native language script directly into the service request.

Roth shows four primary embodiments (i.e., the embodiments of Figs. 1, 4, 5, and 6). The embodiments of Figs. 1, 4, and 5 all show the transfer of queries from client computer 102 to the search engine as an XML message without any embedded call to native language script. The embodiment of Fig. 6 shows that the search tools and conversion modules are all located within client computer 102, such that there is no transfer of an incompatible query from client computer 102. Thus, none of the embodiments of Roth can meet the requirements of MPEP 2131. Furthermore, as explained below, it is improper for the Examiner to attempt to combine these mutually exclusive embodiments in a manner to find all of the "pieces" of Applicants' claimed invention without showing the claimed invention in total.

With regard to the rejection of claim 1, the first limitation is a piece of hardware (i.e., "user terminal") coupled to a second piece of hardware (i.e., a "legacy data base management system") via a the claimed network. In making his rejection, the Examiner cites client computer 102 of Fig. 6 as discusses at page 7, paragraph 0087. It is noted that client computer 102 of Fig. 6 contains all of the logic associated with conversion of an XML message to an SQL query. Perhaps to cloud the issue, the Examiner cites paragraphs 0020, 0021, and 0044 which do not appear to relate to any particular one of the disclosed embodiments.

The second element of claim 1 is a "service request" which is transferred to the claimed "legacy data base management system" for honoring. In making his rejection, the Examiner cites page 7, paragraphs 0085-0086, which clearly discusses the embodiment of Fig. 5, wherein element 508 is the SQL Statement Generation Module located within server computer 150. As explained above, the embodiment of claim 5 transfers an XML message from client computer 102 to server computer 150.

The third claimed element is the "facility" located within the user terminal which embeds the call to native script. To find this element, the Examiner returns to the embodiment of Fig. 6 citing element 508. This is in direct opposition to his finding of the service request from the embodiment of Fig. 5 wherein element 508 is located within server computer 150 rather than client computer 102.

To make this distinction even more explicit, claim 1 has been amended to require "a converter located within said legacy data base management system". Though this element was implied by the previous presentation of claim 1, it is now explicit that the claimed "facility" is located within the claimed "user terminal" and the claimed "converter" is located within the claimed "legacy data base management system". This limitation is fully supported throughout Applicants' disclosure and summarized at page 12, lines 13-18.

Clearly, the Examiner cannot read both of these claimed elements (i.e., "facility" and "converter") on SQL Statement Generation Module 508, which is located in server computer 150 of the embodiment of Fig. 5 and in client computer 102 of the embodiment of Fig. 6. In any given embodiment, Roth only teaches a single SQL Statement Generation Module 508.

The rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed for failure of Roth to meet the requirements of MPEP 2131.

Claim 2 depends from claim 1 and further limits the "native script" called by the "service request" generated by the "user terminal". As explained above, Roth does not have the claimed "service request" with the embedded call to native script. Therefore, the Examiner cites page 3, paragraph 0023, which does not say anything of the claimed service request with the embedded call to native script as claimed. The rejection of claim 2 is respectfully traversed.

Claims 3 and 25 depend from claims 2 and 24, respectively. Claim 25 thus contains all of the limitations of claims 23 and 22 from which claim 24 depends. However, at page 11, paragraph 8, of the pending official action, the Examiner expressly admits that Roth does not contain all of the limitations of claim 22 from which claim 25 depends. Therefore, the rejection of claim 25 is respectfully traversed as a matter of law in view of the

Examiner's express admission that Roth does not meet the requirements of MPEP 2131.

Claim 3 further limits the "service request" generated by the claimed "user terminal". In making his rejection, the Examiner cites page 4, paragraph 0056, which cites yet another mutually exclusive embodiment of Roth (i.e., the embodiment of Fig. 1). The rejection of claim 3 is respectfully traversed for failure of Roth to meet the requirements of MPEP 2131.

Claims 4 and 8 depend from claims 3 and 7, respectively. Though both of these claims have different scopes with different limitations, they are all further limited by a "repository" for the storage of executable script. In making his rejection, the Examiner cites Fig. 5, elements 150 and 508. Neither of these elements show the claimed "repository". The rejection of claims 4 and 8 is respectfully traversed for failure of the Examiner to address the claimed invention and for failure of Roth to meet the requirements of MPEP 2131.

Claims 5, 10, and 19 depend from claims 4, 9, and 18, respectively, and further limit the coupling network of the claimed invention. As explained above, Roth does not meet the limitations of claims 4, 9, and 18. Therefore, Roth cannot meet these further limitations. The rejection of claims 5, 10, and 19 is respectfully traversed.

Claim 6 is an independent apparatus claim having five separate element coupled together in a specific manner. In making his rejection, the Examiner cites relational data base 160 to correspond to the second claimed element, "legacy data base management system". Because there is no XML message transferred to Fig. 6, element 160, the Examiner finds that the third claimed element corresponds to the XML message of the embodiment of Fig. 1 by citing page 4, paragraph 0056. Thus, the Examiner impermissibly uses pieces of the mutually exclusive embodiments of Figs. 1 and 6 to show the second and third claimed elements.

The fourth claimed element is a "converter". In making his rejection, the Examiner jumps back to the embodiment of Fig. 6. To assist the Examiner in understanding Applicants' invention, claim 6 has been amended to explicitly require that the "converter" be located within the claimed "legacy data base management system". As explained above, support for this limitation is found at page 12, lines 13-18, of the specification. This is readily distinguishable from the Examiner's current rejection wherein client computer 150 of Roth.

The fifth claimed element is the "module" which performs the embedding of the native script at generation in the claimed service request in XML. Again, the Examiner cites the embodiment of Fig. 6 wherein the SQL query is generated. Therefore, the

rejection of amended claim 6, and all claims depending therefrom, is respectfully traversed.

Claim 7 depends from claim 6 and further limits the claimed "native script" and the "internal format" of the claimed "database management system". As explained above, Roth has no structure for embedding "native script" into the claimed XML service request. Therefore, Roth cannot have the further limitations of claim 7. The rejection of claim 7 is respectfully traversed.

Claim 9 depends from claim 8 and is further limited by a "response" generated by the claimed "database management system". Roth does not have the limitations of claim 8 for the reasons provided above. Therefore, Roth cannot have the claimed "response". The rejection of claim 9 is respectfully traversed.

Claim 11 is an independent method claim having four steps. The first step requires: "transferring an XML document having a call to native script to said legacy data base management system via a publicly accessible digital data communication network". Roth has no "call to native script" within an XML document. Therefore, the Examiner makes the legally irrelevant statement:

> {See page 4, paragraph 0056, lines 1-5, also see page 3, paragraph 0044, deemed to show client server connection via Internet, Figure 6, shows "legacy data base management system deemed to be implemented on a "relational database")

This finding is legally irrelevant, because it does not address Applicants' claimed invention. Even if the findings were not clearly erroneous and impermissibly supported by mutually exclusive embodiments of Roth, they are not relevant. Not only does Roth not show the claimed element, the Examiner does not even allege that it does.

As originally presented, it is implied that the "converting" step occurs within the data base management system, because it occurs after and is responsive to the "transferring" step. On that basis alone, the "converting" step cannot occur within the user terminal. Nevertheless, the Examiner cites page 7, paragraph 0089, to show conversion by SQL Statement Generation Module 608, located within client computer 102 (see Fig. 6). Therefore, to assist the Examiner, Applicants have herewith amended claim 11 to even more explicitly require the claimed "converting" to occur within the claimed "legacy data base management system". This is not found in Roth.

The third step is limited by "embedding" of the native script into the XML document. As explained above, this is found nowhere within Roth. Therefore, the Examiner ignores Applicants' claimed invention and irrelevantly states:

> (See Figure 6, 160, shows relational database residing within the server computer receiving requests, wherein "legacy database management system" is deemed to run on the relational database, also see page 2, paragraph 0020)

It is absolutely baffling why anyone would consider this statement to be relevant to the claimed third (i.e., "embedding") step. The fourth step requires presentation of the converted XML document to the claimed "legacy database management system" which is not found in Roth. The rejection of claim 11, and all claims depending therefrom, is respectfully traversed for failure of Roth to meet the requirements of MPEP 2131 and for failure of the Examiner to address Applicants' claimed invention.

Claim 16 is an independent apparatus claim having four "means-plus-function" limitations. As to the first two claimed elements, the Examiner cites the embodiment of Fig. 1 of Roth "to show client server connection via Internet" and the mutually exclusive embodiment of Fig. 6 to show "wherein 'legacy database management system' is deemed to run on the relational database". He completely ignores the fact that no XML documents are transferred between client computer 102 and server computer 150 of Fig. 6.

Again, as originally presented, it is clearly implied that the claimed "converting means" must be located within the claimed "providing means". Nevertheless, the Examiner cites the embodiment of Fig. 6 of Roth wherein the alleged "converting means" is located within client computer 102. To assist the Examiner in this regard, claim 16 has been amended to even more

explicitly require that the "converting means" must be located within the claimed "providing means". This is not found in Roth.

The final element of claim 16 is an "embedding means" which embeds the native script call into the service. This is not found in Roth so the Examiner again cites the embodiment of Fig. 6. As explained above, Roth does not embed any native script. The rejection of amended claim 16, and all claims depending therefrom, is respectfully traversed for failure of Roth to meet the requirements of MPEP 2131.

Claim 17 depends from claim 16 and further limits the "providing means" to include a "repository means". This element is not found in Roth. The rejection of claim 17 is respectfully traversed.

Claim 18 depends from claim 17 and is further limited by a "defining means for defining the native service". Because this limitation is not found in Roth, the Examiner confusingly cites paragraphs 0013, 0081, 0082, and 0086. Not withstanding these extensive citations, the claimed limitation is not mentioned, taught, suggested, or even implied. The rejection of claim 18 is respectfully traversed.

Claim 20, as amended, depends from claim 19 (and therefore from claim 18) is further limited by the "repository means" storing the "defining means" of claim 18 "for future use". Roth

says nothing about storage for future use. The rejection of claim 20 is respectfully traversed.

Claim 21 is an independent apparatus claim having three basic elements. Roth has none of these elements. The first element is a "user terminal" which makes an XML data processing service request and receives a corresponding response. There is no showing that the user terminal receives the claimed "response". As explained above, the "converter" cannot be located within the user terminal as suggested by the Examiner by citing the embodiment of Fig. 6 of Roth.

The third claim element is a "legacy database management system" which "executes said native command language wherein said service request is honored by execution of an ordered sequence of statements of said native command language". Roth has no such element. Instead, the Examiner cites paragraphs 0066-0068 to show that Roth permits simple queries from a relational data base. The rejection of claim 21, and all claims depending therefrom, is respectfully traversed.

Claims 23 and 24 depend from claim 22. The Examiner admits that Roth does not have all of the limitations of claim 22. Therefore, claims 23 and 24 which depend from claim 22 are not anticipated by Roth as a matter of law. The rejections of claims 23 and 24 are respectfully traversed.

Claims 12-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of U.S. Patent No. 6,611,843, issued to Jacobs (hereinafter referred to as "Jacobs"). This ground of rejection is respectfully traversed for failure of the Examiner to make a *prima facie* case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1)motivation to make the alleged combination; 2)reasonable likelihood of success of the alleged combination; and 3)all claimed elements within the alleged combination. The Examiner has failed to make any of these three required showings. Therefore, because the Examiner has not made a *prima facie* case of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

In an apparent attempt to show motivation, the Examiner concludes:

> Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a (sic) XML DTD since (sic) its (sic) an inherit (sic) party (sic) of the protocol representing a collection of XML markup declarations that, as a collection, defines the legal (sic) structure, elements, and attributes that are available for use in a document that complies to (sic) the DTD.

This statement is largely incomprehensible, so it is difficult to ascertain the Examiner's exact position on the matter. However, to the extent the Examiner alleges "inherency", his findings do

not meet his burden under MPEP 2112. On the other hand, to the extent that the Examiner alleges the combination of Jacobs with Roth is necessary to operate, it is a finding that Roth is inoperative. In either case, the statement appears to have nothing to do with presenting evidence and/or argument of why one would be motivated to make the alleged combination as required by controlling law.

The Examiner completely ignores his obligation to show reasonable likelihood of success. The Examiner also fails to show all of the claimed elements within the alleged combination as explained below.

Claim 12 depends from claim 11 and further limits the "converting" step. The Examiner alleges that Roth shows the "converting" step without the use of a DTD corresponding to the XML document "having a call to native script". The alleged combination does not have this element. Therefore, it cannot have the claimed DTD used to convert the XML document "having a call to native script". The rejection of claim 12 is respectfully traversed.

Claim 13 depends from claim 12 and is further limited by "storing said native script in a repository located within said legacy data base management system". Because the alleged combination does not have this claimed step, the Examiner cites Roth, Fig. 5, elements 150 and 508 which say nothing of the

claimed invention. The rejection of claim 13 is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

Claim 14 depends from claim 13 and further limits the claimed "native script". As explained above, the alleged combination does not meet all of the limitations of claim 13 from which claim 14 depends. Therefore, the alleged combination cannot meet all of the limitations of claim 14. The rejection of claim 14 is respectfully traversed.

Claim 15 depends from claim 14 and further limits the claimed network. As explained above, the alleged combination does not meet all of the limitations of claim 14 from which claim 15 depends. Therefore, the alleged combination cannot meet all of the limitations of claim 15. The rejection of claim 15 is respectfully traversed.

Claim 22 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of U.S. Patent Publication No. 2003/0023463 A1, issued in the name of Dombroski et al (hereinafter referred to as "Dombroski"). This rejection is respectfully traversed for failure of the Examiner to make a *prima facie* case of obviousness as specified by MPEP 2143.

As to motivation, the Examiner concludes:

As to claim 22 Roth does not teach wherein said legacy database management system further comprises a mainframe computer.

> Dombroski et al. teaches wherein said legacy database management system further comprises a mainframe computer (See Dombroski et al. Page 6, paragraph 0061).
>
> Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a legacy DBM (i.e., SQL) running mainframe computers (sic).

It is difficult to understand why someone would be motivated to make the alleged combination from this syllogism which is both legally and logically incorrect.

Again, the Examiner completely ignores his obligation to show reasonable likelihood of success.

Claim 22 depends from claim 21 and further limits the claimed "legacy data base management system". As explained above, the alleged combination does not meet all of the limitations of claim 24 from which claim 22 depends. Therefore, the alleged combination cannot meet all of the limitations of claim 22. The rejection of claim 22 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

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By their attorney,

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